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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,134	01/21/2000	William J. Baer	STL000012US1	5405

23373 7590 05/03/2004

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EXAMINER

PHAM, HUNG Q

ART UNIT	PAPER NUMBER
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2172

25

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/489,134

Applicant(s)

BAER ET AL.

Examiner

HUNG Q PHAM

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>21, 22 and 24</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/16/2003 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 10/16/2003, 01/29/2004 and 04/03/2004 was filed after the mailing date of the Request for Continued Examination on 10/16/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 1, 6, 8-14, 18, 20-21, 24-27, 30-31, 36, 38-44, 48, 50-51, 55-57, 60-61, 66, 68-74, 78, 80-81, 85-87, 90-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poole et al. [USP 6,006, 242].**

Regarding to claims 1, 31 and 61, Poole teaches an apparatus and method for dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form (Col. 1, Lines 15-20). As shown in FIG. 1, a document developer initiates a document production session by defining the requirements of the document at step 32. Each of the constituent portions of the document is associated

with an entity reference, which is selected by the document developer at step 34 (Col. 5, Lines 1-10). As shown in FIG. 2, via a user interface 20, a document developer can select entity references representative of content to be included in a document (Col. 5, Lines 41-44). As shown in FIG. 5, the document instance 1\_62 is defined to include entity references &1, &2, and &4. During the document construction procedure, the entity reference &1 is read from the document instance 1\_62 and compared against the entries of the Catalog 26. A match is determined between the entity reference &1 and the ENTITY1 identifier stored in the Catalog 26. The reference to INFENG in the associated resolution strategy indicates that entity reference &1 is to be resolved by employment of an Inference Engine 28. The Inference Engine 28 resolves entity reference &1 to document component A\_66, which is linked to paragraph 1\_94 of regulation Z\_90 (Col. 7, Lines 28-58). As seen, entity references as *a plurality of selectable object is presented to a user* via a user interface, each entity reference or *object represents* a paragraph, a section... of regulation Y\_80 and Z\_90 as *a subset of the collection of content*. Poole does not explicitly teach the step of *creating a hierarchical compilation of the content represented by each selected object in response to selection by a user of one or more of said objects*. However, as further disclosed by Poole in FIG. 4, in some cases, an entity reference that has been resolved may include one or more entity references, which require resolving. In such a case, as is tested at step 133, any remaining unresolved entity references that are nested within the resolved entity reference are resolved at step 131 (Col. 7, Lines 1-6). Returning to FIG. 5, upon resolving all of the entity references contained in a document instance, a prepared

document 65 may then be produced. The prepared document 65 may be published as a printed form, an electronic form, or a Web or Internet form, for example (Col. 8, Lines 26-30). As seen, the paragraphs or sections that correspond to entity references are collected and edited into prepared document 65, an entity reference with nested entity references indicates a hierarchical structure, and the process of orderly collecting and editing the entity reference with nested entity references, obviously, is a *hierarchical compilation*. In different words the technique as discussed indicates the step of *creating a hierarchical compilation of the content represented by each selected object in response to selection by a user of one or more of said objects*. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole technique by having a hierarchical grouping and editing in order to resolve the nested entity references into a predefined document.

Regarding to claims 6, 36 and 66, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses *the collection of content comprises hierarchically related data* (Col. 7, Lines 1-6).

Regarding to claims 8, 38 and 68, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses *displaying to the user the selected objects in a predetermined order such that the user may rearrange the order of the selected objects as desired through a user interface* (FIG. 1).

Regarding to claims 9, 39 and 69, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses the step of *defining a maximum amount of allowable content per volume of content; creating a plurality of volumes of content from the selected content based upon the defined maximum* (FIG. 17).

Regarding to claims 10, 40 and 70, Poole teaches all the claimed subject matters as discussed in claims 9, 39 and 69, Poole further discloses the step of *displaying to the user the selected objects contained in each volume such that the user may selectably move an object from a first to a second of the volumes* (Col. 11, lines 25-50).

Regarding to claims 11, 41 and 71, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses the step of *receiving content input by a user and creating a selectable object from the content* (Col. 8, lines 5-30).

Regarding to claims 12, 42 and 72, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses *the user may concurrently create a plurality of compilations* (FIG. 1).

Regarding to claims 13, 43 and 73, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses the step: *after creation of the compilation, presenting the compilation to a user for modification* (FIG. 4).

Regarding to claims 14, 44 and 74, Poole teaches all the claimed subject matters as discussed in claims 13, 43 and 73, Poole further discloses the step of *creating a copy of the compilation, applying changes input by a user to the copy, and creating a new compilation therefrom* (Col. 10, lines 5-16).

Regarding to claims 18, 48 and 78, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses the step: *after creation of the compilation, of submitting the compilation to an approval process* (FIG. 3).

Regarding to claims 20, 50 and 80, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses: *the presenting step further comprises the step of presenting all of the content comprising the collection of content to the user as a plurality of selectable objects* (FIG. 1).

Regarding to claims 21, 51 and 81, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses: *the presenting step further comprises the step of presenting less than all of the content comprising the collection of content to the user as a plurality of selectable objects* (FIG. 1).

Regarding to claims 25, 55 and 85, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses *a selectable object further comprises one of a container and a content entity* (FIG. 5).



Regarding to claims 26, 56 and 86, Poole teaches all the claimed subject matters as discussed in claims 25, 55 and 85, Poole further discloses *in response to selection of the container to add to a compilation, adding the selected container and any containers or content entities it contains to the compilation* (FIG. 5).

Regarding to claims 27, 57 and 87, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses *the selectable objects further comprise titles of their associated subsets of content* (FIG. 5).

Regarding to claims 24, 54 and 84, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses *at least one of the subsets of content is associated with one or more prerequisite subsets of content and upon selection by the user of a selectable object associated with the at least one subset, also including the associated prerequisite subsets of content in the created compilation* (Col. 7, Lines 1-6).

Regarding to claims 30, 60 and 90, Poole teaches an apparatus and method for dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form (Col. 1, Lines 15-20). As shown in FIG. 1, a document developer initiates a document production session by defining the requirements of the document at step 32. Each of the constituent portions of the document is associated with an entity reference, which is selected by the document developer at step 34 (Col. 5,

Lines 1-10). As shown in FIG. 2, via a user interface 20, a document developer can select entity references representative of content to be included in a document (Col. 5, Lines 41-44). As shown in FIG. 5, the document instance 1\_62 is defined to include entity references &1, &2, and &4. During the document construction procedure, the entity reference &1 is read from the document instance 1\_62 and compared against the entries of the Catalog 26. A match is determined between the entity reference &1 and the ENTITY1 identifier stored in the Catalog 26. The reference to INFENG in the associated resolution strategy indicates that entity reference &1 is to be resolved by employment of an Inference Engine 28. The Inference Engine 28 resolves entity reference &1 to document component A\_66, which is linked to paragraph 1\_94 of regulation Z\_90. The content of regulation Z\_90 may then be incorporated into a final document 65 by referencing document component A\_66 (Col. 7, Lines 28-60). As seen, entity references are presented to a user via a user interface, each entity reference represents a paragraph, a section... of regulation Y\_80 and Z\_90 as *content entities*, then the selected paragraphs or sections that correspond to entity references are collected and edited into prepared document 65, or in different words, *creating a compilation from the selected content entities*. Poole does not explicitly teach the step of creating *in response to selection of ones of the hierarchically related elements to include in a hierarchical compilation*. However, as further disclosed by Poole in FIG. 4, in some cases, an entity reference that has been resolved may include one or more entity references, which require resolving. In such a case, as is tested at step 133, any remaining unresolved entity references that are nested within the resolved entity

reference are resolved at step 131 (Col. 7, Lines 1-6). As seen, *in response to the selection* of entity references, the process of resolving as discussed includes the selected entity reference with nested entity references as *hierarchically related elements*, and the process of orderly collecting and editing the entity reference with nested entity references, obviously, is a *hierarchical compilation*. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole technique by having a hierarchical grouping and editing in order to resolve the nested entity references into a predefined document.

Regarding to claims 91, 94 and 97, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses: *the compilation of content is created automatically in response to the user selecting said one or more of said objects* (FIG. 3).

Regarding to claims 92, 95 and 98, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses *the compilation of content is created by recording in a computer-readable structure defining the compilation, for each selected object, a reference to the content entity associated with the selected object* (FIG. 5).

Regarding to claims 93, 96 and 99, Poole teaches all the claimed subject matters as discussed in claims 92, 95 and 98, Poole further discloses *the computer-readable structure defining the compilation in a custom content outline (CCO) containing the*

*references that correspond to the selected objects, and wherein said references are identifiers of the content entities associated with the selected objects (FIG. 5).*

5. Claims 2-3, 29, 32-33, 59, 62-63 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poole et al. [USP 6,006, 242] in view of Guck [USP 5,864,870], and ksinclair.com [Free E-books You Can Download].

Regarding to claims 2, 32 and 62, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole further discloses *the collection of content comprises at least one of a document, an image* (Poole, Col. 4, lines 31-39). Poole does not teach *the collection of content comprises at least one of a book, a collection of musical selection, and a video*. However, an e-book, in general, has a plurality of section with textual content as in ksinclair.com. Guck teaches a storage device stores different objects such as audio, video (Guck, FIG. 3). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by including e-book, audio, and video in the collection of content in order to construct an electronic book embedded with audio, and video.

Regarding to claims 3, 33 and 63, Poole, Guck, and ksinclair.com teaches all the claimed subject matters as discussed in claims 2, 32 and 62, ksinclair.com further discloses *subsets of content comprise one of a chapter and sections of a text document* (ksinclair.com).

Regarding to claims 29, 59 and 89, Poole teaches all the claimed subject matters as discussed in claims 25, 55 and 85, Poole further discloses *the collection of content comprises at least one of an image album* (Poole, Col. 4, lines 31-39). Poole does not teach *the collection of content comprises at least one of a book, and videos*. However, an e-book, in general, has a plurality of section with textual content as in ksinclair.com. Guck teaches a storage device stores different objects such as video (Guck, FIG. 3). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by including e-book, and video in the collection of content in order to construct an electronic book embedded with video.

**6. Claims 4-5, 7, 19, 28, 34-35, 37, 49, 58, 64-65, 67, 79 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poole et al. [USP 6,006,242] in view of ksinclair.com [Free E-books You Can Download].**

Regarding to claims 4, 34 and 64, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, but fails to disclose *each selectable object is associated with a cost, and further comprising the step of calculating a cost for the created compilation based upon the costs of the selected objects*. Ksinclair.com has a website that presenting a plurality of e-books to a user and a user could open or download the e-book to the user site by selecting the title of an e-book. Ksinclair.com further discloses *each selectable object is associated with a cost* but fails to disclose the step of *calculating a*

*cost for the created compilation based upon the costs of the selected objects.* However, a cost for a created compilation is a service charge based on the cost of maintaining an object such as an e-book and could be calculated upon the cost of that e-book. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by applying the cost of an object from ksinclair.com method and including the cost of created compilation based upon the cost of the object in order to maintain the system.

Regarding to claims 5, 35 and 65, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, but fails to disclose the step of *determining a content count for the compilation and determining a cost for the compilation based upon the content count.* Ksinclair.com has a website that presenting a plurality of e-books to a user and a user could open or download the e-book to the user site by selecting the title of an e-book. The downloadable ksinclair.com e-book has a table of content with a content count and a cost associated with the e-book (ksinclair.com). Thus the cost of the compilation for a particular chapter could be calculated based upon the content count. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by applying the cost of an object from ksinclair.com method and including the cost of created compilation based upon the content count in order to maintain the system.

Regarding to claims 7, 37 and 67, Poole teaches all the claimed subject matters as discussed in claims 6, 36 and 66, Poole further disclose *the collection of content comprises text documents and the subset of content associated with each selectable object comprises at least one of a section* (Poole, FIG. 5). Ksinclair.com has a website for e-book that presenting a plurality of e-books to a user and a user could open or download the e-book to the user site by selecting the title of an e-book. The downloadable ksinclair.com e-book has a table of content including chapters (ksinclair.com). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by including e-books as selectable objects with associated chapters in order collect and edit the content associated with an e-book as a selected object.

Regarding to claims 19, 49 and 79, Poole teaches all the claimed subject matters as discussed in claims 18, 48 and 78, Poole further discloses: *the approval process further comprises one of approving the compilation for publication; rejecting the compilation* (Poole, FIG. 3 & Col. 10, lines 11-24). Poole does not teach the step of *receiving editorial comments as input from a second user, and providing the compilation and editorial comments to the creating user*. Ksinclair.com has a website that presenting a plurality of e-books to a user and a user could open or download the e-book to the user site by selecting the title of an e-book. A user could send an email to Ksinclair.com for advising the author (ksinclair.com). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by

including the step of receiving editorial comments from a second user in order to have a more friendly-user system.

Regarding to claims 28, 58 and 88, Poole teaches all the claimed subject matters as discussed in claims 25, 55 and 85, but fails to disclose *containers are at least one of a book, a volume, and a chapter*. Ksinclair.com has a website for e-book that presenting a plurality of selectable objects as e-books to a user and a user could open or download the e-book to the user site by selecting the title of an e-book. The downloadable ksinclair.com e-book is a container that has a table of content including other containers such as chapters and sections. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Pajak method by including e-books as a container with associated containers such as chapters and sections in order collect and edit the content associated with an e-book as a selected object.

**7. Claims 15-17, 22-23, 45-47, 52-54, 75-77 and 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poole et al. [USP 5,877,445] in view of Duwaer et al. [USP 5,959,627].**

Regarding to claims 15, 45 and 75, Poole teaches all the claimed subject matters as discussed in claims 13, 43 and 73, Poole fails to disclose *the user may select an object for removal from the compilation*. Duwaer teaches a method, computer program, and a



system that allows for fast and carefree compiling in a database that may easily run into many hundreds of audio items (Col. 1, lines 25-29). Duwaer further discloses *the user may select an object for removal from the compilation* (FIG. 5). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by including the technique of removing an object from a compilation in order to compile a document.

Regarding to claims 16, 46 and 76, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole fails to disclose *the user may select to clear the compilation*. Duwaer teaches a method, computer program, and a system that allows for fast and carefree compiling in a database that may easily run into many hundreds of audio items (Col. 1, lines 25-29). Duwaer further discloses *the user may select to clear the compilation* (FIG. 5). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by including the technique of selecting to clear an object from a compilation in order to compile a document.

Regarding to claims 17, 47 and 77, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole fails to disclose *the user may select to undo an operation affecting the compilation*. Duwaer teaches a method, computer program, and a system that allows for fast and carefree compiling in a database that may easily run into many hundreds of audio items (Col. 1, lines 25-29). Duwaer further discloses *the user*

*may select to undo an operation affecting the compilation* (FIG. 5). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by including the technique of undoing an object from a compilation in order to compile a document.

Regarding to claims 22, 52 and 82, Poole teaches all the claimed subject matters as discussed in claims 21, 51 and 81, Poole fails to disclose the step of *partitioning the collection of content into a plurality of categories, and presenting all content objects belonging to a category to a user*. Duwaer teaches a method, computer program, and a system that allows for fast and carefree compiling in a database that may easily run into many hundreds of audio items (Col. 1, lines 25-29). Duwaer further discloses the step of *partitioning the collection of content into a plurality of categories, and presenting all content objects belonging to a category to a user* (FIG. 5). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by including the technique of partitioning an object from a compilation in order to compile a document.

Regarding to claims 23, 53 and 83, Poole teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Poole fails to disclose the step of *receiving search criteria input by the user; determining which of the subsets of the collection of content satisfy the search criteria; and presenting to the user a plurality of selectable objects corresponding to the subsets of content satisfying the search criteria*. Duwaer teaches a method, computer

program, and a system that allows for fast and carefree compiling in a database that may easily run into many hundreds of audio items (Col. 1, lines 25-29). Duwaer further discloses the step of *receiving search criteria input by the user; determining which of the subsets of the collection of content satisfy the search criteria; and presenting to the user a plurality of selectable objects corresponding to the subsets of content satisfying the search criteria* (Col. 4, lines 30-41). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Poole method by including the technique of searching an object in order to compile a document.

**8. Claims 1, 6-8, 11-23, 25-28, 30-31, 36-38, 41-53, 55-58, 60-61, 66-68, 71-83, 85-88, 90-91, 94 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over by The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing].**

Regarding to claims 1, 31 and 61, McGraw-Hill Companies (McGraw-Hill) discloses a method of compiling a customized textbook from a collection of content stored in a database (pages 1-3) by *presenting a plurality* of sections of a book as *selectable objects to a user, each section or object representing a subset of the collection of content* (pages 7, 9 and 12). In order to build a complimentary custom book, the user can select any presented section to compile into his/her complimentary custom book (pages 7, 9 and 12). In different words the technique of compilation as discussed indicates the step of *creating a compilation of the content represented by each selected object*

*in response to selection by a user of one or more of said objects.* McGraw-Hill does not explicitly teach the technique of compiling is *a hierarchical compilation*. However, as disclosed on page 3, a user can combine selection from any discipline in any order. Thus, a section of a chapter in The Legal and Regulatory Environment of Business on page 7 could be selected to compile under a section of Managerial Accounting on page 9 as a sub section. By organizing the complimentary custom book into orders, obviously, the technique of compiling a complimentary custom book is *a hierarchical compilation*. It would have been obvious for one of ordinary skill in the art at the time the invention was made to use the McGraw-Hill technique of compiling to have hierarchical compiled objects in order to build a complimentary custom book from a plurality of fields of study.

Regarding to claims 6, 36 and 66, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses *the collection of content comprises hierarchically related data* (page 7).

Regarding to claims 7, 37 and 67, McGraw-Hill teaches all the claimed subject matters as discussed in claims 6, 36 and 66, McGraw-Hill further disclose *the collection of content comprises text documents and the subset of content associated with each selectable object comprises at least one of a section* (pages 3 and 7).

Regarding to claims 8, 38 and 68, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses *displaying to the user the selected objects in a predetermined order such that the user may rearrange the order of the selected objects as desired through a user interface* (Review and Resequene, page 9).

Regarding to claims 11, 41 and 71, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses the step of *receiving content input by a user and creating a selectable object from the content* (pages 5-7).

Regarding to claims 12, 42 and 72, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses *the user may concurrently create a plurality of compilations* (pages 7, 9 and 12).

Regarding to claims 13, 43 and 73, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses the step: *after creation of the compilation, presenting the compilation to a user for modification* (page Review and Resequene of page 9).

Regarding to claims 14, 44 and 74, McGraw-Hill teaches all the claimed subject matters as discussed in claims 13, 43 and 73, McGraw-Hill further discloses the step of

*creating a copy of the compilation, applying changes input by a user to the copy, and creating a new compilation therefrom* (page 3).

Regarding to claims 15, 45 and 75, McGraw-Hill teaches all the claimed subject matters as discussed in claims 13, 43 and 73, McGraw-Hill further discloses *the user may select an object for removal from the compilation* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding to claims 16, 46 and 76, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses *the user may select to clear the compilation* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding to claims 17, 47 and 77, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill does not explicitly disclose *the user may select to undo an operation affecting the compilation*. However, undo an operation that affecting a compilation is a conventional operation such as the undo in Word Editor. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by including the technique of undoing an object from a compilation in order to compile a document.

Regarding to claims 18, 48 and 78, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses the claimed *after creation of the compilation, of submitting the compilation to an approval process* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding to claims 19, 49 and 79, McGraw-Hill teaches all the claimed subject matters as discussed in claims 18, 48 and 78, McGraw-Hill further discloses *the approval process further comprises one of approving the compilation for publication; rejecting the compilation* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding to claims 20, 50 and 80, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses *the presenting step further comprises the step of presenting all of the content comprising the collection of content to the user as a plurality of selectable objects* (page 7).

Regarding to claims 21, 51 and 81, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses *the presenting step further comprises the step of presenting less than all of the content comprising the collection of content to the user as a plurality of selectable objects* (pages 5-7).

Regarding to claims 22, 52 and 82, McGraw-Hill teaches all the claimed subject matters as discussed in claims 21, 51 and 81, McGraw-Hill further discloses the step of

*partitioning the collection of content into a plurality of categories, and presenting all content objects belonging to a category to a user (page 5).*

Regarding to claims 23, 53 and 83, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses the step of *receiving search criteria input by the user; determining which of the subsets of the collection of content satisfy the search criteria; and presenting to the user a plurality of selectable objects corresponding to the subsets of content satisfying the search criteria (pages 5-6).*

Regarding to claims 25, 55 and 85, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses *a selectable object further comprises one of a container and a content entity (page 7).*

Regarding to claims 26, 56 and 86, McGraw-Hill teaches all the claimed subject matters as discussed in claims 25, 55 and 85, McGraw-Hill further discloses *in response to selection of the container to add to a compilation, adding the selected container and any containers or content entities it contains to the compilation (Microsoft Powerpoint presentation presenting how to user Primis Online).*

Regarding to claims 27, 57 and 87, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses *the selectable objects further comprise titles of their associated subsets of content (page 7).*



Regarding to claims 28, 58 and 88, McGraw-Hill teaches all the claimed subject matters as discussed in claims 25, 55 and 85, McGraw-Hill further discloses *containers are at least one of a book, a volume, and a chapter* (page 7).

Regarding to claims 30, 60 and 90, McGraw-Hill Companies (McGraw-Hill) discloses a method of compiling a customized textbook from a collection of content stored in a database (pages 1-3) by presenting a plurality of books as *content objects*, each book comprising a plurality of chapters and sections as *hierarchically related content entities* (pages 7, 9 and 12). In order to build a complimentary custom book, the user can select any presented section to compile into his/her complimentary custom book (pages 7, 9 and 12). In different words the technique of compilation as discussed indicates the step of *creating a compilation from selected content entities in response to selection of ones of the hierarchically related elements to include in a compilation*. McGraw-Hill does not explicitly teach the technique of compiling is *a hierarchical compilation*. However, as disclosed on page 3, a user can combine selection from any discipline in any order. Thus, a section of a chapter in The Legal and Regulatory Environment of Business on page 7 could be selected to compile under a section of Managerial Accounting on page 9 as a sub section. By organizing the complimentary custom book into orders, obviously, the technique of compiling a complimentary custom book is *a hierarchical compilation*. It would have been obvious for one of ordinary skill in the art at the time the invention was made to use the McGraw-Hill technique of compiling to have

hierarchical compiled objects in order to build a complimentary custom book from a plurality of fields of study.

Regarding to claims 91, 94 and 97, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses *the compilation of content is created automatically in response to the user selecting said one or more of said objects* (page 7).

**9. Claims 2-3, 29, 32-33, 59, 62-63 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing] in view of Mortimer et al. [USP 6,091,930].**

Regarding to claims 2, 32 and 62, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further discloses *the collection of content comprises at least one of a book, a document, an image* but does not teach a *collection of musical selections and a video*. Mortimer teaches a technique of creating a customized student book and the collection of content comprises a collection of musical selections and a video (Mortimer, FIG. 2a). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by including audio, and video in the collection of content in order to construct an electronic book embedded with audio, and video.

Regarding to claims 3, 33 and 63, McGraw-Hill and Mortimer teaches all the claimed subject matters as discussed in claims 2, 32 and 62, McGraw-Hill further discloses *subsets of content comprise one of a chapter and sections of a text document* (McGraw-Hill, page 7).

Regarding to claims 29, 59 and 89, McGraw-Hill teaches all the claimed subject matters as discussed in claims 25, 55 and 85, McGraw-Hill further discloses *the collection of content comprises at least one of a book* (McGraw-Hill, page 5). McGraw-Hill does not teach *the collection of content comprises at least one of image album and videos*. Mortimer teaches a technique of creating a customized student book and the collection of content comprises image album and a video (Mortimer, FIG. 2a). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by including image and video in the collection of content in order to construct an electronic book embedded with image and video.

**10. Claims 4-5, 34-35 and 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing] in view of ksinclair.com [Free E-books You Can Download].**

Regarding to claims 4, 34 and 64, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, but fails to disclose *each selectable object is associated with a cost, and further comprising the step of calculating a cost for the created compilation based upon the costs of the selected objects*. Ksinclair.com has a website that presenting a plurality of e-books to a user and a user could open or download the e-book to the user site by selecting the title of an e-book. Ksinclair.com further discloses *each selectable object is associated with a cost* but fails to disclose the step of *calculating a cost for the created compilation based upon the costs of the selected objects*. However, a cost for a created compilation is a service charge based on the cost of maintaining an object such as an e-book and could be calculated upon the cost of that e-book. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by applying the cost of an object from ksinclair.com method and including the cost of created compilation based upon the cost of the object in order to maintain the system.

Regarding to claims 5, 35 and 65, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill further disclosed the step of *determining a content count for the compilation* (McGraw-Hill, page 7), but not the step of *determining a cost for the compilation based upon the content count*. Ksinclair.com has a website that presenting a plurality of e-books to a user and a user could open or download the e-book to the user site by selecting the title of an e-book. The downloadable ksinclair.com e-book has a cost associated with the e-book

(ksinclair.com). Thus the cost of the compilation for a particular chapter could be calculated based upon the content count. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by applying the cost of an object from ksinclair.com method and including the cost of created compilation based upon the content count in order to maintain the system.

**11. Claims 9-10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over by The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing] in view of Poole et al. [USP 6,006, 242].**

Regarding to claims 9, 39 and 69, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, but does not disclose the step of *defining a maximum amount of allowable content per volume of content; creating a plurality of volumes of content from the selected content based upon the defined maximum*. Poole teaches an apparatus and method for dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form (Poole, Col. 1, Lines 15-20). Poole further discloses the step of *defining a maximum amount of allowable content per volume of content; creating a plurality of volumes of content from the selected content based upon the defined maximum* (Poole, FIG. 17). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill

technique by including the step of defining a maximum amount of content in order to compile an e-book online.

Regarding to claims 10, 40 and 70, McGraw-Hill and Poole teaches all the claimed subject matters as discussed in claims 9, 39 and 69, Poole further discloses the step of *displaying to the user the selected objects contained in each volume such that the user may selectably move an object from a first to a second of the volumes* (Poole, Col. 11, lines 25-50).

Regarding to claims 24, 54 and 84, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, but does not explicitly disclose *at least one of the subsets of content is associated with one or more prerequisite subsets of content and upon selection by the user of a selectable object associated with the at least one subset, also including the associated prerequisite subsets of content in the created compilation*. Poole teaches an apparatus and method for dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form (Poole, Col. 1, Lines 15-20). Poole further discloses *at least one of the subsets of content is associated with one or more prerequisite subsets of content and upon selection by the user of a selectable object associated with the at least one subset, also including the associated prerequisite subsets of content in the created compilation* (Col. 7, Lines 1-6). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill technique

to include the nested object in order to compile an e-book with embedded pictures or graphics.

Regarding to claims 92, 95 and 98, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 31 and 61, McGraw-Hill does not explicitly disclose *the compilation of content is created by recording in a computer-readable structure defining the compilation, for each selected object, a reference to the content entity associated with the selected object*. Poole teaches an apparatus and method for dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form (Poole, Col. 1, Lines 15-20). Poole further discloses *the compilation of content is created by recording in a computer-readable structure defining the compilation, for each selected object, a reference to the content entity associated with the selected object* (FIG. 5). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill technique by referencing the content entities in order to compile an e-book.

Regarding to claims 93, 96 and 99, McGraw-Hill and Poole teaches all the claimed subject matters as discussed in claims 92, 95 and 98, Poole further discloses *the computer-readable structure defining the compilation in a custom content outline (CCO) containing the references that correspond to the selected objects, and wherein said references are identifiers of the content entities associated with the selected objects* (FIG. 5).


**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q PHAM whose telephone number is 703-605-4242. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Hung Pham  
April 22, 2004

  
SHAHID ALAM  
PRIMARY EXAMINER